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10/720,002	11/24/2003	Gregory E. Ross	150449C1	3973
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ANDREWS KURTH LLP			EXAMINER	
1350 I STREET, N.W.			JOLLEY, KIRSTEN	
SUITE 1100			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005			1792	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,002

Applicant(s)

ROSS, GREGORY E.

Examiner

Kirsten C. Jolley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 2, 2008 has been entered.

Reissue Declaration

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. Applicant's declaration merely states that claims are presented that are broader in scope than the original patent claims. The declaration is defective because it does not properly state what error is being corrected with enough specificity. MPEP 1414 part II (C) states in part:

Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. A statement of "... failure to include a claim directed to ..." and then presenting a newly added claim, would not be considered a sufficient "error" statement *>because< applicant has not pointed out what the other claims lacked that the newly added claim has, or vice versa.

3. Claims 23-43 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

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The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Response to Arguments/Amendments

4. It is noted that the format of the claims does not comply with reissue practice. Because all claims present are newly added claims with respect to the original patent, the new claims should be underlined in their entirety.

5. The 35 USC 112, 1st paragraph and 35 USC 102(b) rejections set forth in the prior Office action have been withdrawn in response to Applicant's amendments to the claims. However, upon further search and consideration of the amended claims, the art of Skrivanek et al. and Regan et al. are now applied.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites the limitation "modifying at least the portion" in line 1. There is insufficient antecedent basis for this limitation in the claim. Further this limitation is vague and indefinite because it is confusing. Claim 23 appears to require that modifying is performed by contracting or expanding the first coating, which contradicts claim 28.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 23, 25, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Skrivanek et al. (US 5,650,217).

Skrivanek et al. discloses a method of forming a pattern of at least two coatings onto a base substrate comprising: providing a base substrate; applying a first expandable coating to at least part of the base; applying a second coating over at least a portion of the first coating, where the second coating is dark, dense color; and applying energy to said portion of the first coating through an over-covered region of the second coating such that the first coating expands to form a pattern (see abstract and col. 7). As to claim 25, Skrivanek et al. teaches that the second coating is dark, dense color, preferably black, and thus substantially opaque. Skrivanek et al. also teaches that the second coating may be printing-applied ink, may be in the form of inked indicia, and may comprise metal (col. 7, lines 21-34). As to claim 27, the first and second coatings are applied to the side of a substrate.

Claim Rejections - 35 USC § 102/103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 23, 25, 27-29, 31-34, 36-39, and 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Regan et al. (US 4,210,693).

Regan et al. discloses a method of forming a pattern of at least two coatings onto a base substrate comprising: providing a base substrate 14 having at least three surfaces; applying a first foamable coating 17 on at least part of the substrate; applying at least a second coating over at least a portion of the first coating; and applying energy to the first coating through an over-covered region of the second coating wherein the first coating expands to form a pattern (col. 3, line 56 to col. 4, line 23).

With respect to independent claims 32, 37, and 41, which require coating on the edge of the base substrate to form edge alignment, it is noted that Figure 2 illustrates that the right side of the product is an edge (since it has a straight-line edge, as opposed to the left side which indicates that the product continues to the left) and there are first 17 and second 19 coatings thereon at the edge. Alternatively, if Applicant contends that Figure 2 does not illustrate an edge, it would have been obvious for one having ordinary skill to have applied the first foamable coating 17 and second actinic radiation coating 19 at the edges of the substrate 14 because Regan et al. implies that the entire substrate is coated (which would include the edges) and because

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Regan et al. discloses the use of knife-on-roll coaters which would apply coatings to the edges as well as the centers.

As to claim 25, Regan et al. discloses application of a decorative ink coating applied on top of the foamable coating 17. Alternatively, as to claims 25, 34, 38, the actinic radiation coating may be considered an ink since it may be applied using printing stations (col. 3, lines 5-7) and since it may be colored (col. 6, line 34).

As to claims 28-29, 31, and 40, Regan et al. discloses that its product may be used as floor or wall covering or as a sheet good for coating metals, glass, or wood, etc. (col. 1, lines 11-16, and col. 4, lines 21-22). Thus the product would be transferred to a material or object. In the case of transferring to a glass object/material, it is noted that the substrate and coatings thereon would be proximate a see-through surface, and the edges would define light passages.

As to claim 33, Regan et al. teaches that the substrate may be formed of plastic (col. 7, lines 5-8).

As to claim 36, it is noted that the actinic radiation curable coating is light absorbing.

Claim Rejections - 35 USC § 103

12. Claims 24, 26, and 28-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skrivanek et al.

As to claim 24, Skrivanek et al. teaches that the first and second coating materials may be initially applied to a substrate 112 and then the coated substrate may be transferred or adhered to an object (col. 13, lines 21-27). Alternatively, Skrivanek et al. teaches that the coatings may be first applied to a substrate having a release coating thereon, and then transferring the coatings to

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a substrate (col. 5, line 65 to col. 6, line 3, and col. 8, lines 56-67). While Skrivanek et al. does not expressly teach the use of heat or pressure to transfer or adhere the coatings to an object/substrate, it would have been obvious for one skilled in the art to have used either heat or pressure to adhere the coated substrate to the object since such means for enhancing adhesion are well known in the art. As to claims 29-31, it would have been obvious to have adhered the coated substrate to a see-through surface since Skrivanek et al. teaches that its invention can be applied to “any object”. Skrivanek et al. uses the example of applying its invention to a door. It is well known that doors are often made of see-through glass, and thus it would have been obvious to one having ordinary skill in the art to have applied the invention of Skrivanek et al. to a see-through glass door. As to claim 29, it would have been obvious to have used adhesive for adhering the coated substrate since the use of adhesive is a well known means for adhering one object to another.

With respect to claims 32-43, Skrivanek et al. teaches that its invention “can be applied to any object, whether flat or three-dimensional” (col. 13, lines 22-23). Skrivanek et al. discloses application to a nonwoven, plastic substrate, which is a substrate having at least three surfaces including a desired pattern of edges. Further, Skrivanek et al. teaches that the first coating is applied over the entire surface of the substrate, which would be inclusive of the edges (see claim 1). Skrivanek et al. does not disclose that its second coating is applied along the edges of the substrate with perimeter coating alignment along at least one edge. However Skrivanek et al. broadly discloses the application of any pattern or “any visually perceptible image” for its second coating (col. 7, lines 24-26), and the reference is not limiting as to the placement of the second coating in any way but rather is a matter of design preference. It would have been obvious to

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one having ordinary skill in the art to have applied the second coating of Skrivanek et al. along at least one edge as a matter of design preference with the expectation of successful results, thus resulting in perimeter coating alignment of the coatings and substrate.

As to claims 34-36 and 38, as discussed above, Skrivanek et al. teaches that the second coating is dark, dense color, preferably black, and thus substantially opaque. Skrivanek et al. also teaches that the second coating may be printing-applied ink, may be in the form of inked indicia, may be light absorbing, or may comprise metal (col. 7, lines 21-34).

Claims 39-40 are rejected for the same reasons discussed above with respect to claims 24 and 26.

13. Claims 24, 30, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Regan et al.

Regan et al. discloses that its product may be used as floor or wall covering or as a sheet good for coating metals, glass, or wood, etc. (col. 1, lines 11-16, and col. 4, lines 21-22), as discussed above with respect to claims 28-29, 31, and 40. The means for transfer/adherence are not disclosed. It would have been obvious for one skilled in the art to have used adhesive ("liquid" or "treatment") and pressure to adhere the coated substrate of Regan et al. to a material or object such as a floor or wall or glass material, etc. since such means for enhancing adhesion are well known in the art.

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Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wolinski et al. (US 3,864,181) is cited for its teaching of applying a foamable, expandable coating to a substrate and then applying an overcoat thereon, and thereafter subjecting the composite to a heat treatment to expand the first coating.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Tuesday and Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kirsten C Jolley/
Primary Examiner, Art Unit 1792

kcj